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EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/787,501

Applicant(s)

RODWAY, GILES HENRY

Examiner

Kevin R Kruer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Specification*

1. The amendment filed August 18, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows:

*For the purpose of continuity, the examiner's comments will make reference to the numbered paragraphs of the amendments to the specification*

*1-no new matter; Applicant deleted a heading*

*2-no new matter; Applicant deleted a heading*

*3-no new matter; Applicant has deleted matter*

*4-no new matter; Applicant has deleted a paragraph*

*5-no new matter; Applicant deleted a heading*

*6-no new matter; the amended paragraph has support in the original disclosure*

*7-no new matter; Applicant has amended a heading*

**8-NEW MATTER:**

*The original disclosure does not contain support for the three newly added lines at the end of the paragraph. Specifically, there is no support for the newly added "in one or more areas such as resistance to abrasion, peeling (especially if one of layers is damaged), blistering (especially if heat is applied), delamination, creasing and wrinkling (especially when the insulation is subject to mechanical stress or exposure to solvents.)"*

*9-no new matter; Applicant has deleted a paragraph*

**10-NEW MATTER:**

*The original disclosure does not have support for the first layer to contain "non-polymeric" components. Said limitation is much broader than what the original disclosure supported (page 4, 3<sup>rd</sup> paragraph).*

*Furthermore, there is no support for the second layer to contain "non-polymeric" components.*

*The original disclosure stated that the carbonyl containing polymer "preferably" has a non-aromatic backbone. The original disclosure only has support for carbonyl containing polymers with non-aromatic backbones.*

*There is no support in the original disclosure for the newly claimed "metallic conductor."*

*There is no support in the original disclosure of a second layer comprising a blend of PVDF and the VDF copolymer.*

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**11-NEW MATTER**

*The original disclosure contains no support for the newly added paragraph. Applicant argues that the paragraph only refers to the normal rules of interpretation, but the examiner respectfully disagrees.*

*12-no new matter*

*13-no new matter: Applicant has added a new heading*

**14-NEW MATTER**

*The original disclosure does not contain any support for the carbonyl-containing polymer to be blended with "any other polymer."*

*15-no new matter: Applicant has deleted a paragraph*

**16-NEW MATTER**

*The original disclosure does not contain support for the enumerated additives to be added to layer (ii).*

*The original disclosure also does not contain support for the broader disclosure that any "non-polymeric component" may be added to the composition.*

*The original disclosure also does not contain support for "non-polymeric" antioxidants, pigments, fillers, flame retardants, etc.*

*17-no new matter: Applicant has deleted a paragraph*

*18-no new matter; Applicant has deleted a paragraph*

*19-no new matter*

**20-NEW MATTER**

*The original disclosure does not contain support for the newly added last four lines of the paragraph. Specifically, there is no support for the following: "In some embodiments of the invention, the first layer is in direct contact with the conductor. In some embodiments of the invention, the defined first and second layers are the sole insulation around the conductor. In other embodiments, the first and second layers are part of multilayer insulation including one or more other layers."*

*21-no new matter*

*22-no new matter*

*23-no new matter*

Applicant is required to cancel the new matter in the reply to this Office Action.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 28-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the original disclosure for a first layer comprising "a first non-polymeric component."

There is no support in the original disclosure for a second layer comprising "a second non-polymeric component."

There is no support in the original disclosure for a carbonyl-containing polymer that does not have a non-aromatic backbone.

There is no support in the original disclosure for a "metallic conductor."

There is no support in the original disclosure for a second layer comprising a blend of PVDF and the VDF copolymer.

4. Claims 30 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure for the claimed method (b). Specifically, there is no support in the original disclosure for immersing the wire in an acetone bath with a depth of 4.2mm. The original disclosure states that the wire is

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immersed at a depth "equivalent to 70% of the length of the wire (see page 5 of the specification).

5. Claims 31 and 37-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the specification enables one of ordinary skill in the art to blend the carbonyl polymer with HDPE, there is no support for the broader disclosure that the carbonyl polymer may be blended with any polyolefin.

6. Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure for a second layer comprising a blend of PVDF and the VDF copolymer.

7. Claims 47-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the specification enables one of ordinary skill in the art to blend the carbonyl

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polymer with HDPE, there is no support for the broader disclosure that the carbonyl polymer may be blended with any polyethylene.

8. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure of "bringing the respective layers into contact with each other at a temperature above the melting or softening point of the polymeric material of at least one layer."

9. Claim 54 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for a method of coextruding the layers (i) and (ii) onto the conductor in a single pass of the conductor from an extrusion process pay-out device to an extrusion process take-up device.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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11. The rejection of claims 1-5, 9-11, 13, 15, 17-21, 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over WO97/27260 in view of Vodges et al (US 4,693,940) has been overcome by amendment.

12. The rejection of claims 8 and 24 under 35 U.S.C. 103(a) as being unpatentable over WO97/27260 in view of Vodges et al (US 4,693,940), as applied to claims 1-5, 9-11, 13, 15, 17-21, 25 and 26 above, and further in view of Suzuki et al (US 4,454,249) has been overcome by amendment.

13. The rejection of claims 12 and 27 under 35 U.S.C. 103(a) as being unpatentable over WO97/27260 in view of Vodges et al (US 4,693,940), as applied to claims 1-5, 9-11, 13, 15, 17-21, 25 and 26 above, and further in view of Bilow (US 3,632,441) has been overcome by amendment.

14. The rejection of claim 14 under 35 U.S.C. 103(a) as being unpatentable over WO97/27260 in view of Vodges et al (US 4,693,940), as applied to claims 1-5, 9-11, 13, 15, 17-21, 25 and 26 above, and further in view of Lagow et al (US 4,621,107) has been overcome by amendment.

15. The rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over WO97/27260 in view of Vodges et al (US 4,693,940), as applied to claims 1-5, 9-11, 13, 15, 17-21, 25 and 26 above, and further in view of Dola (US 4,606,595) has been overcome by amendment.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.



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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*K-R K*

Kevin R. Kruer

*Paul Thibodeau*

Paul Thibodeau  
Supervisory Patent Examiner  
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